

## REMARKS

In response to the Office Action dated December 10, 2009, Applicants respectfully request reconsideration of the rejections of the claims.

Claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16 - 19, and 22 - 26 are rejected under 35 U.S.C. § 102(e), on the basis of US 6,873,426, hereinafter *Farrell*.

Claims 3, 6, 9, 12, 15, and 20 were rejected under 35 USC 103(a) on the basis of *Farrell* in view of *Jeyachandran* (US 6,567,176). Claim 21 was rejected on the basis of *Farrell* in view of *Jeyachandran* and *Trovinger* (US 6,708,967).

For the reasons discussed hereinafter, it is respectfully submitted that these references do not teach or suggest the claimed subject matter to a person of ordinary skill in the art, whether considered individually or in combination.

Claim 1 recites, among other elements, a printing system comprising an on-line client, a print server, a printer capable of performing a first set of finishing specifications, as well as an off-line finishing device capable of performing a second set of finishing specifications. A first memory stores the first set of finishing specifications of the on-line printer and the second set of finishing specifications of the off-line finishing device. The print server further includes a sorter for, based on the information regarding the specifications that are stored in the first memory, separating the finishing specifics included in the job ticket received by the receiver into those to be performed by the on-line printer and those to be performed by the off-line finishing device. In contrast to the usage in *Farrell*, the present application clearly defines what is meant by off-line. "...'off-line' means that the device is not connected to any of the other devices of the printing system via either route [i.e.,

locally or via a network]." See paragraph [0032] of the published application US 2002/0042798.

As set forth in claim 1, the claimed sorter bases the separating on the finishing specifications that **can be performed** by the printer and the finishing device, respectively. Accordingly, *Farrell* cannot teach such separating based on specifications and installed options that can be performed by the finishing device 18 since, as is clear from block 44 in Figure 3, the specifications referred to in blocks 50, 52 are not specifications that can be performed by the finisher 18.

In addition, *Farrell* teaches that all of the finishing options are to be performed by the finishing device 18. Thus, finisher 18 is the only structure in *Farrell* that is capable of performing finishing. In contrast, claim 1 recites that the printing system includes a sorter for separating finishing specifics included in a job ticket into those **to be performed by the on-line printer** and **those to be performed by the off-line finishing device**. Thus, the claim requires that there are two finishing devices - one that is on-line with the print server and connected to the printer and the other that is off-line. *Farrell* does not teach separating finishing instructions into those that can be accomplished by two different units.

In the prior response, it was argued that the *Farrell* patent does not disclose a printing system that stores information about an on-line printer and a distinct, i.e., off-line, finishing device, such that it is able to assign finishing specifics between the on-line printer and the finishing device about which it has the information. Rather, to the extent that the system of the *Farrell* patent stores information about finishing capabilities, it is only information about the finishing element 18 of the printer. Thus,

the *Farrell* patent only discloses that information relating to the automated finishing capabilities of the printer itself are stored.

The alternate finishing instructions described at column 5, lines 9 - 22, pertain only to the finishing element 18 of the printer 16. Nowhere does the *Farrell* patent suggest that the printing system has knowledge of any of the particulars of an off-line finisher.

Accordingly, *Farrell* does not teach or suggest claim 1.

Claims 2 - 15 are patentable at least for reasons similar to those set forth above.

Claim 16 recites a print server to be used in a printing system including a client, the print server, a printer capable of performing a first set of finishing specifications, and a finishing device that is separately provided from the printer and capable of performing a second set of finishing specifications. The print server comprises a first memory section that stores information on the finishing specifications of the printer and the finisher; and a control section that separates the finishing specifics included in the job ticket received by the receiving section into a first group of finishing specifics to be performed by the printer and a second group of finishing specifics to be performed by the finishing device separately provided from the printer.

The Examiner alleges that such features are taught by *Farrell*. As set forth in claim 16, the claimed control section separates the finishing specifics included in the job ticket into a first group of finishing specifics to be performed by the printer and a second group of finishing specifics to be performed by the finishing device separately provided from the printer.

Accordingly, *Farrell* cannot teach such separating based on specifications that can be performed by the finishing device 18 since, as is clear from block 44 in Figure 3, the specifications referred to in blocks 50, 52 are not specifications that can be performed by the finisher 18.

In addition, *Farrell* teaches that the finishing options are to be performed by the finishing device 18. Thus, the finisher 18 is the only structure in *Farrell* that is capable of performing finishing. In contrast, claim 16 recites a printer capable of performing a first set of finishing specifications, and a finishing device that is separately provided from the printer and capable of performing a second set of finishing specifications.

Thus, the claim requires that there are two finishing devices - one that is installed on the printer and the other that is provided separately. *Farrell* does not teach separating finishing instructions in to those that can be accomplished by two different units.

In the prior response, it was argued that the *Farrell* patent does not disclose a printing system that stores information about an on-line printer and a distinct finishing device that is provided separately, such that it is able to assign finishing specifics between the on-line printer and the finishing device about which it has the information. Rather, to the extent that the system of the *Farrell* patent stores information about finishing capabilities, it is only information about the finishing element 18 of the printer. Thus, the *Farrell* patent only discloses that information relating to the automated finishing capabilities of the printer itself are stored.

The alternate finishing instructions described at column 5, lines 9 - 22, pertain only to the finishing element 18 of the printer 16. Nowhere does the *Farrell* patent

suggest that the printing system has knowledge of any of the particulars of an off-line finisher.

Accordingly, *Farrell* does not teach or suggest claim 16. Claims 17 - 26 are patentable for similar reasons.

Claims 3, 6, 9, 12, 15, 20, and 21 are rejected under 35 USC 103(a) as being allegedly unpatentable over *Farrell* in combination with U.S. patent No. 6,567,176, hereinafter *Jeyachandran*. For claim 21, U.S. Patent No. 6,708,967, hereinafter *Trovinger* is also used. However, the features relied upon from *Jeyachandran* do not overcome the deficiencies set forth above with regard to *Farrell*.

With regard to *Trovinger*, the Examiner alleges that the finishing device is an off-line device. However, that also does not overcome the fact that *Farrell* does not teach or suggest the two different devices for finishing. Accordingly, neither *Jeyachandran* nor *Trovinger* overcome the deficiencies of *Farrell* that are outlined above.

Other distinguishing features of the invention are set forth in the dependent claims. In view of the fundamental difference identified above, a further discussion of these additional distinctions is believed to be unnecessary at this time.

For the foregoing reasons, it is respectfully submitted that all pending claims are patentably distinct from the prior art of record. Reconsideration and withdrawal of the rejections, and allowance of all pending claims is respectfully requested.

Applicants respectfully request reconsideration and withdrawal of the rejections, and allowance of all pending claims.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: April 9, 2010

By: /WCRoland/  
William C. Rowland  
Registration No. 30,888

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620